

**REMARKS**

This Amendment and Response to Office Action is made in response to the examiner's office action dated August 10, 2005, and is accompanied by a Request for Continued Examination under 37 CFR 1.114. No new matter is added by this amendment.

The examiner's comments have been carefully considered, and are addressed in turn in the following paragraphs.

Variety Denomination

In order to expedite allowance of this application, applicant has, by the foregoing amendment, changed the varietal name to 'Mesembrine' as required by the examiner.

Objection under 37 C.F.R. 1.163 and Rejection under 35 U.S.C. §112

The specification has been objected to as failing to provide a full and complete disclosure of the plant and its distinguishing characteristics. By the foregoing amendment, Applicant has provided additional information to more fully describe the claimed plant, and to more clearly distinguish it from other known cultivars.

The examiner has renewed her request for additional botanical information. Except where noted, the following requested information has been supplied by way of the foregoing amendment.

- Depth and width of stem cavity
- Fertility
- Flesh characteristics
- Bearing

- Fruit lenticels
- Fruit ripening date
- Blossom fragrance
- Chilling requirement – This information has not been provided, because the minimum number of chilling hours required for the claimed plant is unknown. Minimum chilling hours are significant in warmer growing climates, such as California, but not in central Washington state, where the present variety was tested.
- Rootstock used
- Clarification of anthocyanin coloration of fruit skin and flesh
- Leaf gland description – Applicant has described the leaf glands, also known as “nectaries,” of the claimed plant at page 5, lines 18-20.
- Time of leaf bud burst – This information has not been provided, because the date of leaf bud burst was not previously recorded. Due to the seasonal availability of this information, it is not possible for applicant to obtain it at this time. Applicant therefore requests that this requirement be waived.
- Petiole description

With the addition of the foregoing information to the specification, applicant has supplied all information requested by the examiner, to the extent that the information is available.

Rejection under 35 U.S.C. §102(e)

The claim in this application stands rejected under 35 U.S.C. §102(e). The examiner

cites U.S. Patent No. 12,438 and “the prior art in general” as the basis for this rejection. To anticipate a claim, a reference must teach every element of the claim. MPEP §2131, citing *Verdegaal Bros. v Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A plant patent claim has but a single element, the plant described, and is expressed in formal terms. 37 C.F.R. §1.164 (“The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics.”) Unless the claimed plant, the one and only element in the plant patent claim, is disclosed in a cited reference (or in “the prior art in general”), the reference does not anticipate.

The Federal Circuit has held that the scope of a plant patent claim is limited to the plant described in the patent, and its asexually reproduced progeny. *Imazio Nurseries, Inc. v. Dania Greenhouses*, 69 F.3d 1560, 1568 (Fed. Cir. 1995). The *Imazio* court held that only a plant that is the asexually propagated progeny of the patented plant can infringe the plant patent. *Id* at 1569. Given the well established truth that anticipation and infringement are reciprocals , only a plant that is the asexually propagated progeny or predecessor of the claimed plant can anticipate the claimed plant. See, for example, *Knapp v. Morss*, 150 US 221, 228 (1893) (“That which infringes, if later, would anticipate, if earlier”). Neither the reference cited by the examiner nor “the prior art in general” disclose the claimed plant or its asexually propagated progeny or predecessor. Absent such a disclosure, there is no valid basis for a rejection of the claim in this application under 35 U.S.C. §102(e).

The claimed plant was not sold or made publicly available, under any name, anywhere in the world prior to August 15, 2001.

**CONCLUSION**

Applicant believes that the foregoing amendment and remarks fully address the examiner's stated concerns. Allowance of the application is therefore requested at this time. Any final questions or comments relating to this application may be directed to applicant's representative who signs below.

Respectfully Submitted,

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*SUBSTITUTE SPECIFICATION WITH MARKINGS TO SHOW CHANGES MADE*

TITLE OF THE INVENTION

Nectarine Tree '~~S-6606~~' 'Mesembrine'

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CROSS REFERENCE TO RELATED APPLICATIONS

None

PRIORITY CLAIM

10 This application claims priority of U.S. Provisional patent application Ser. No.  
60/404,079 filed August 15, 2002.

STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT

None

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LATIN NAME OF THE GENUS AND SPECIES OF THE PLANT CLAIMED

*Prunus persica* L. Batsch

VARIETY DENOMINATION

20 '~~S-6606~~' 'Mesembrine'

BRIEF DESCRIPTION OF THE PHOTOGRAPHS

FIG. 1 shows the tree and blossoms of 'S-6606' 'Mesembrine';

FIG. 2 shows the blossoms of 'S-6606' 'Mesembrine';

FIG. 3 shows the leaves of 'S-6606' 'Mesembrine'; and

FIG. 4 shows the fruit of 'S-6606' 'Mesembrine'.

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#### BRIEF DESCRIPTION OF THE VARIETY:

The new nectarine tree 'S-6606' 'Mesembrine' originated as a seedling resulting from a controlled cross of 'Jalousia' x 'Summergrand' (seed parent, not patented) and 'Fantasia' (pollen parent, not patented). Originally bred and tested by the Institut National de la Recherche

10 Agronomique (INRA) in France, 'S-6606' 'Mesembrine' has been asexually propagated by grafting in France and in Parker, Washington, USA, and has been observed to remain true to type over successive asexually propagated generations.

'S-6606' 'Mesembrine' was selected for its broad oblate shape and pleasant sub-acid flavor. While similar in many respects to 'S 6816' (plant patent pending), the fruit of 'S-6606'

15 'Mesembrine' matures one to two weeks later. It has also been observed that the leaves of 'S 6606' 'Mesembrine' are longer than those of 'S 6816.'

#### DETAILED BOTANICAL DESCRIPTION OF THE VARIETY:

The following detailed botanical description is based on observations of four year old trees  
20 made during the 2004 growing season at Parker, Washington. The test trees were grown on 'Lovell' (unpatented) rootstock. All colors are described according to the Royal Horticultural Society Colour Chart. It should be understood that the characteristics described will vary somewhat depending upon

cultural practices and climatic conditions, and can vary with location and season. Quantified measurements are expressed as an average of measurements taken from a number of individual plants of the new variety. The measurements of any individual plant, or any group of plants, of the new variety may vary from the stated average.

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**Tree**

Type Non-spur type

Vigor Medium

Habit Upright

10 Size Width 2.2 m; height 3.9 m

Production Heavy

**Trunk**

Size Diameter 34.1 at base

15 Bark Texture varies; color grey 201D on very rough bark;  
greyed-purple 183A on rough bark; greyed-purple 184A on  
smooth bark

Lenticels Large, prominent, length 0.8 to 1.1 cm; 10 per square inch;  
color orange-white 159A

**Flowering Branch**

20 Size Length 50.8 cm; diameter 1.6 cm

Texture Smooth

Length of internodes Medium, 2.2 to 2.5 cm

Color Greyed-purple 184A

Anthocyanin coloration Present

Intensity of anthocyanin coloration Medium

#### Flowers

- 5 Abundance of flower buds Medium
- Distribution of flower buds Generally in groups of two or more
- Time of beginning of flowering Bud burst March 18; bloom period March 21 to April 6, 2005
- 10 Buds Length 0.8 to 0.9 cm; elongated with rounded tip; color red-purple 59A, tip red-purple 63B; hardy
- Flower shape Rosaceous
- Fragrance Fragrant, not sweet
- Flower size Diameter 3.6 to 3.9 cm
- Calyx color (open flower before falling of petals) Orange
- 15 Petals Quantity 5; overlapping; large, length 1.5 to 1.6 cm, width 1.4 to 1.5 cm; margins ruffled; petal texture smooth; color upper surface red-purple 62D, lower surface red-purple 61D
- Number of pistils Always one
- 20 Position of stigma compared to anthers Below
- Stamen length compared to petals Shorter
- Anthers Size 0.05 cm; color greyed-red 180A; pollen present, yellow 1A

<del>Pubescence of ovary</del>		Absent
Stamen		Quantity 36; length 1.0 to 1.2 cm; color red-purple
		62D
Filament		Size 0.9 to 1.1 cm
5	Pistil	Size 1.0 to 1.2 cm; color yellow 1A
Sepals		Length 0.5 to 0.6 cm; width 0.3 to 0.4; color red-purple
		59A
<u>Fertility</u>		<u>Self-fertile</u>

## Leaves

10	Time of leaf bud burst	Medium
Size		Medium, length 13.0 cm, width 4.0 cm
Ratio length/width		Medium
Profile		Flat
Curvature of tip		Recurved downward
15	Angle at base	Nearly right angle
Angle at top		Medium
Anthocyanin coloration		Absent
Color		Yellow-green 146A with yellow-green 146D spots

## Petiole

20	Length	Medium, <u>1.5 cm</u>
Nectaries		Present
Shape of nectaries		Kidney-shaped

	Number of nectaries	Normally two
Fruit		
	Size	Small, diameter 7.0 cm; height 4.0 cm
	Shape in profile view	Broad oblate
5	Shape of tip	Bowl shaped depressed
	Symmetry when cut along suture	Symmetric
	Suture	Marked
	Depth of petiole cavity	Broad <u>1.5 cm</u>
	Width of petiole cavity	Broad <u>2.5 cm</u>
10	Color of skin	Ground color orange-red 34B; over color red-purple 59A
	Extension of anthocyanin coloration of skin	Very large
	Pubescence	Absent
	<u>Lenticels</u>	<u>Absent</u>
	Thickness of skin	Medium
15	Adherence of skin	Medium
	Firmness of flesh	Very firm
	Anthocyanin coloration directly under skin	Absent
	Anthocyanin coloration around the stone	<del>Absent</del> <u>Present</u>
	Texture of the flesh	Not fibrous, <u>fine, melting</u>
20	Sugar content of flesh	High, Brix 13.5
	Color of flesh	Yellow 16C; color near seed yellow N30A
	Flavor	Sub-acid, skin slightly tart

## Stone

Size compared to fruit Small, diameter 2.5 cm  
Shape Flat; ridged; pitted  
Color Red-purple 59B  
5 Likelihood of stone to split Absent or very weak  
Adherence to flesh Yes  
Degree of adherence to flesh Medium

## Maturity

Bearing Annual

10 Time of maturity Early (August 4, 2004 at Parker, Washington)  
Duration Multiple pickings  
Preharvest drop Absent or minimal  
Time of falling of leaves Medium  
Resistance to pests and diseases None noted

**ABSTRACT**

A new cultivar of nectarine tree (*Prunus persica* L. Batsch) named 'S-6606' 'Mesembrine' is disclosed. The fruit of 'S-6606' 'Mesembrine' is notable for its broad oblate shape and sub-acid flavor.